UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,859	04/27/2005	Carlos Portasany Sanchez	P/189-362	4887

2352   7590   02/07/2008
OSTROLENK FABER GERB & SOFFEN
1180 AVENUE OF THE AMERICAS
NEW YORK, NY 100368403

EXAMINER
KARIKARI, KWASI

ART UNIT	PAPER NUMBER
2617	

MAIL DATE	DELIVERY MODE
02/07/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	10/522,859	PORTASANY SANCHEZ, CARLOS
	Examiner	Art Unit	
	Kwasi Karikari	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 December 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Response to Arguments

1.   Applicant's arguments, filed on 12/11/2007 with respect to claims 1-15 in the

remarks, have been considered but are moot in view of the new ground(s) of rejection

necessitated by the new limitations added to claims 1, 9-11 and 15. See the rejection

below of claims 1, 9-11 and 15 for relevant citations found in AAPA and Nachef

disclosing the newly added limitations.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a
background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1.   Determining the scope and contents of the prior art.

2.   Ascertaining the differences between the prior art and the claims at issue.

3.   Resolving the level of ordinary skill in the pertinent art.

4.   Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-12 are rejected under U.S.C. 103(a) as being unpatentable over

Applicant's Admitted Prior Art (hereinafter AAPA) in view of Nachef et al. (U.S.

20050207562 A1), (hereinafter Nachef).

Regarding **claims 1 and 9,** AAPA discloses a mobile telephone device (= mobile

telephone see Page 1, lines 20-31), comprising:

an integrated circuit card with a subscriber identity module or a universal

subscriber identity module, said card comprising a storage operable for storing at least

one application (= SIM card application, see Figure 1, items 3A, 4A and Page 1, lines

29-35);

a device operable for remote access management of the card based on remote

access message reception by mobile telephony (= SIM card contain remote manager;

and remote access to SIM card, see Page 3, lines 11-21 and Page 4, lines 12-35);

at least one data array manager (file manager, 2F) module for managing data

arrays of at least one application stored in the card, said at least one data array

manager (file manager) module comprising:

a receiver operable <u>to receive,</u> by <u>means of </u>a remote access message <u>received</u>

<u>by mobile telephony,</u> at least one instruction for operating on at least one piece of data

contained in an array of a specified application (see Page 2, lines 19-35);

an accessing device operable for accessing said array said accessing device

further comprising a receiver operable for receiving from the specified application; the

accessing device being operable for accessing said array; and apparatus operable for

performing at least one operation (= written, read or manipulate, see Page 4, lines 12-

35); on said at least one piece of data (Figure 1, item 4D) in said array; but fails to teach

an analyzer operable for **analyzing said <u>at least one</u> instruction**, "requested

reference" and "without the necessity of deleting and rewriting the entire specified

application stored in the card".

Nachef teaches that application management between cards 2 and 3 and card 2

can perform administration operations such as **addition 201, modification 203** and

accessing and **installing commands** applets on card 3; followed by an interactive

display on the screen; and proactive command (see Pars. [0006,0041-44; 0072-75

0080-0114 and Fig. 1, item 3]); whereby the modification and installing reads on and

"without the necessity of deleting and rewriting **the entire** specified application stored in

the card.

It would therefore have been obvious to one of the ordinary skill in the art to

combine the teaching of Nachef into the system of AAPA for the benefit of achieving a

system whereby SIM card that can be modified based on instructions received from an

administrator which is supplied with SIM Toolkit standard (see Abstract).

Regarding **claim 2,** as recited in claim 1, Nachef's further teaching of deletion and

modification operation on data or applets present in the Sim card (see Abstract), meets

the claimed limitations of claim 2.

It would therefore have been obvious to one of the ordinary skill in the art to

combine the teaching of Nachef into the system of AAPA for the benefit of achieving a

system whereby SIM card that can be modified based on instructions received from an

administrator which is supplied with SIM Toolkit standard (see Abstract).

Regarding **claim 3,** as recited in claim 1, AAPA discloses that said specified application

is a SIM Application Toolkit or a Universal SIM Application Toolkit application (Toolkit

application 3A and 4A, see Page 4, lines 12-35).

Regarding **claim 4,** as recited in claim 1, Nachef's further teaching of deletion and

modification operation on data or applets present in the Sim card (see Abstract), meets

the claimed limitations of claim 4.

It would therefore have been obvious to one of the ordinary skill in the art to

combine the teaching of Nachef into the system of AAPA for the benefit of achieving a

system whereby SIM card that can be modified based on instructions received from an

administrator which is supplied with SIM Toolkit standard (see Abstract).

Regarding **claim 5,** as recited in claim 1, Nachef's further teaching of deletion and

modification operation on data or applets present in the Sim card (see Abstract), meets

the claimed limitations of claim 5.

It would therefore have been obvious to one of the ordinary skill in the art to

combine the teaching of Nachef into the system of AAPA for the benefit of achieving a

system whereby SIM card that can be modified based on instructions received from an

administrator which is supplied with SIM Toolkit standard (see Abstract).

Regarding **claim 6,** as recited in claim 5, Nachef's further discloses the device, wherein said data array manager module is an Application Programming interface (loader program consist of an applet programmed in JAVA, see Pars. [0040 and 0068]).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Nachef into the system of AAPA for the benefit of achieving a system whereby SIM card that can be modified based on instructions received from an administrator which is supplied with SIM Toolkit standard (see Abstract).

Regarding **claim 7,** as recited in claim 1, Nachef's further discloses the device, wherein said device operable for remote access management is based on a GSM 03.48 standard or on a 3GPP 23.048 standard (see Par. [0019]).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Nachef into the system of AAPA for the benefit of achieving a system whereby SIM card that can be modified based on instructions received from an administrator which is supplied with SIM Toolkit standard (see Abstract).

Regarding **claim 8,** as recited in claim 3, AAPA further discloses that the device comprising a terminal supporting said Subscribe Identity Module (SIM) Application Toolkit or said Universal SIM Application Toolkit and also at least one of a supporting Data Download, and a class "e" terminal supporting the SIM Toolkit commands for channel management (see Page 4, lines 12-35).

Regarding **claim 10,** as recited in claim 9, Nachef's further teaching of deletion and modification operation on data or applets present in the Sim card (see Pars. 0010-14, 0063, 0081-93 and Abstract), meets the claimed limitations of claim 10.

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Nachef into the system of AAPA for the benefit of achieving a system whereby SIM card that can be modified based on instructions received from an administrator which is supplied with SIM Toolkit standard (see Abstract).

Regarding **claim 11,** as recited in claim 9, AAPA further discloses receiving said message in a terminal of subscriber equipment; sending said message from said terminal to the card; forwarding the <u>at least one</u> instruction via a remote access manager module in the card to a data array manager module identified in the message (OTA messages are received in the subscriber equipment and transmitted to the card, where the remote access manager takes charge of performing the appropriate operation, see Page 2, lines 19-35 and Page 4, lines 21-24).

Regarding **claim 12,** as recited in claim 11, Nachef's further discloses that the message is of the Data Download type (see Pars. [0040-0044]).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Nachef into the system of AAPA for the benefit of achieving a system whereby SIM card that can be modified based on instructions received from an administrator which is supplied with SIM Toolkit standard (see Abstract).

3.   **Claims 13 and 15 are rejected under U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art in view of Nachef and further in view of Nachef (U.S. 20020137545 A1), (hereinafter Nachef II).**

Regarding claim 13, as recited in claim 12, the combination of AAPA and Nachef fail to teach sending of said message to the card by an ENVELOPE command.

Nachef II teaches sending of said message to the card by an ENVELOPE command (see Par. [0068]).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Nachef II into the system of AAPA and Nachef for the benefit of achieving an increased SIM card Toolkit applications via SIM smart card, thereby increasing processing speed (see Par. [0047]).

Regarding **claim 15,** as recited in claim 13, Nachef further discloses the method, wherein the at least one instruction is forwarded to a data array manager module identified by a Toolkit Application Reference field of the message (see Par. [0063]).

4.   **Claim 14 is rejected under U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art in view of Nachef and further in view of Arques et al. (U.S. 20040131083 A1), (hereinafter Arques).**

Regarding **claim 14,** as recited in claim 11, the combination of AAPA and Nachef fail to teach, wherein the message is sent to the card through a Bearer Independent Protocol-based channel.

Arques teaches wherein the message is sent to the card through a Bearer Independent Protocol-based channel (see Par. [0008]).

It would therefore have been obvious to one of the ordinary skill in the art to combine the teaching of Arques into the system of AAPA and Nachef for the benefit of achieving a method for transmitting data in non-connected mode (see Par. [0018]).
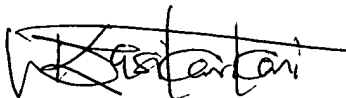
Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of 33the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Kwasi Karikari whose telephone number is

571-272-8566. The examiner can normally be reached on M-F (8 am - 4pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Rafael Pérez-Gutiérrez can be reached on 571-272-7915. The fax phone

number for the organization where this application or proceeding is assigned is 571-

273-8566. Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kwasi Karikari
Patent Examiner.
02/02/2008

Rafael Perez-Gutierrez
Supervisory Patent Examiner
Technology Center 2600
Art Unit 2617

2|4|08